

### **Remarks**

Applicant respectfully requests reconsideration of this application. Claims 45, 47, 51, 55, 62-63 and 69 have been amended. None of the claims have been allowed.

### ***Information Disclosure Statement***

Applicant wishes to disclose the status of other applications that may be considered related to the present application, as follows: serial no.: 10/315,624 (Notice of Allowance mailed 01/26/2010); serial no.: 10/315,694 (issued as US 7,493,078; 02/19/2009); serial no.: 10/367,178 (issued as US 7,593,361; 09/22/2009); serial no.: 10/889,326 (Office Action rejecting all pending claims mailed 09/17/2009); serial no.: 10/608,594 (Office Action rejecting all pending claims mailed 09/17/2009); serial no.: 10/367,197 (issued as US 7,590,084; 09/15/2009); serial no.: 10/315,788 (issued as US 7,558,525; 07/07/2009); serial no.: 10/395,749 (Office Action rejecting all pending claims mailed 07/16/08; appeal brief filed 09/29/2008); serial no.: 10/407,445 (issued as US 7,567,527; 07/28/2009); serial no.: 11/800,543 (issued as US 7,741,665; 12/30/2008); and serial no.: 10/435,005 (issued as US 7,215,660; 05/08/2007).

### ***Traversal of Claim Rejections Under 35 U.S.C. § 103(a)***

Claims 45-72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lau in view of Heinonen et al. (US 6,968,153 "Heinonen") and Lau in view of Oura (US 6,115,369 "Oura"). Applicant respectfully traverses this ground of rejection.

The distinctions between the cited prior art references and the claimed subject matter have been discussed at length in Applicant's previous amendments and arguments. In response to Applicant's argument that Lau does not disclose the

claimed element of a third transceiver, the Examiner maintains his rejection of claims 45-72 based on the same combination of references previously cited. On page 11 of the 09/02/2009 Office Action, the Examiner states that he "respectfully disagrees" adding that,

"The claim merely states the 'third transceiver operable to...' therefore, as long as Lau is capable of such an act the claim limitation is taught. The device of Lau is programmable and capable of such an operation. Furthermore, the claim merely recites that each limitation is 'operable to....' The claim language merely suggests that the system be capable of performing the claim limitation and, further, the claim language following the term 'to' is merely intended use and not given patentable weight."

Applicant respectfully submits that the foregoing statement contradicts the Examiner's position expressed earlier (on page 4) in the same Office Action, wherein the Examiner stated, "*Lau does not disclose a third transceiver coupled to the first and second transceivers, the third transceiver operable to transmit and receive data in a second frequency band.*" (Italics in original)

Additionally, Applicant respectfully submits that the Examiner errs in his legal conclusion that the claim clauses containing the wording "operable to..." are not claim limitations entitled to patentable weight. Clauses such as "adapted to", "wherein", "whereby", and, in the present case, "operable to" are claim limitations that cannot be ignored – and therefore must be given patentable weight – when the claim states a condition that is material to patentability. *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005)

Here, Applicant's claimed apparatus (e.g., "A repeater..." as recited in claim 44) is distinguished from the prior art in terms of structure rather than function. The recitation of distinct first, second and third transceivers, as set forth in the subject claims, defines a structure that is not taught nor suggested in the prior art. See, *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 (Fed. Cir. 1990)

("[A]pparatus claims cover what a device *is*, not what a device *does*.") (emphasis in original)

By alleging that Lau is capable of functioning as Applicant's claimed third transceiver, it seems that the Examiner is asserting that the disputed claim clause is inherent in Lau's teachings. But even assuming *arguendo* that Lau performs all of the functions recited in the amended claims (something which Applicant has strenuously argued is not the case), the fact that the amended claims recite a structural difference, i.e., a third transceiver not disclosed in Lau means that the claimed subject matter is distinguished over Lau.

The facts of the present case are similar to that of *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999). In *Robertson* the claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The Federal Circuit construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.

Even though Applicant considers the wording "operable to.." as limiting the scope of the independent claims, Applicant has nonetheless amended each of the independent claims to remove this wording, which the Examiner contends is non-limiting and therefore not entitled to patentable weight.

As explained in Applicant's previous responses, Applicant also respectfully submits that Lau does not teach a repeater that wirelessly receives and re-transmits on the same frequency channel. Lau discloses that his repeaters are receiving and transmitting *simultaneously*, which is contrary to the language of the subject claims. Lau thus fails to teach the elements and limitations of the claimed invention. Both

Heinonen and Lau fail to teach receiving and transmitting in odd/even time intervals using first and second transceivers.

Furthermore, Applicant contends that a skilled person would also have lacked any motivation to attempt to combine Lau with either Heinonen or Oura since Lau specifically teaches that TDMA approaches are limited to a 1Mbps throughput, a rate that is adequate for a mobile phone system, but which is completely inadequate to transmit real-time audiovisual data content. Applicant therefore respectfully submits that a person of ordinary skill, upon reading the Lau reference, would be discouraged from attempting to implement a wireless repeater having first and second transceivers that receive and transmit on the same frequency channel during odd/even time intervals. Lau also teaches away from technologies that have transmission range limitations, which Bluetooth (as taught by Heinonen) certainly suffers from. Given Lau's disparaging remarks about technologies such as Bluetooth, Applicant respectfully submits that a person of ordinary skill in the art would have lacked any motivation to combine / modify Lau with Heinonen to arrive at the claimed subject matter. Furthermore, Applicant respectfully submits that such an ordinary practitioner would certainly have lacked any reasonable expectation of success at achieving the claimed invention in of any such combination.

Oura, aside from being non-analogous art, discloses that audio information is transmitted at data speeds of 384 kbps. (Column 4, lines 30-39) In contrast, Applicant discloses a wireless repeater transmitting data at a data rate of 11 megabits per second. Given the enormous difference in transmission rates and the completely different problems faced when transmitting content (e.g., video) at high data rates versus low data rate transmission (e.g., simple voice data), Applicant respectfully submits that a person or skill working in the field of wireless networks with repeaters would not consider mobile phone communication systems to be within the same field

of endeavor as the claimed subject matter. Nor would such a person have a reasonable expectation of success at achieving data rates of 11 megabits per second by combining Oura's teachings with that of Lau and Heinonen.

By teaching a system and method that uses repeaters having multiple transceivers that transmit and receive simultaneously on different frequency channels, Lau teaches away from the approach taken by Applicant. A person of skill reading Lau would definitely have been discouraged from attempting the claimed subject matter since Lau teaches away from Applicant's solution. Such a skilled person would also have lacked any motivation to attempt to combine Lau with Oura since Lau specifically teaches that TDMA approaches are limited to a 1Mbps throughput, a rate that is adequate for a mobile phone system, but which is completely inadequate to transmit data at a data rate of 11Mbps.


For all of the reasons given above and in Applicant's previous responses, Applicant respectfully submits that a person of ordinary skill in the art would have lacked any reason to combine or modify the cited prior art references in the manner suggested by the Examiner. And that such an ordinary practitioner would have had no reasonable expectation of success at achieving Applicant's claimed invention in view of the contrary teachings of the cited references.

Applicant respectfully submits that for all the reasons given above that a Applicant respectfully submits that all remaining claims are now in condition for allowance.

Please charge any shortages of fees or credit any overcharges of fees to our  
Deposit Account No. 50-2060.

Respectfully submitted,  
**THE LAW OFFICES OF BRADLEY J. BEREZNAK**

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